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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/472,490    12/23/99    TCHAO    R    102-302RE/CO

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IM22/0630

EXAMINER

WONG, L

ART UNIT

PAPER NUMBER

1761

3

DATE MAILED:

06/30/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/472,490**

Applicant(s)  
**Tchao**

Examiner  
**Leslie Wong**

Group Art Unit  
**1761**



☒ Responsive to communication(s) filed on Feb 28, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-30 and 38-45 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-15 is/are allowed.

☒ Claim(s) 16-30 and 38-45 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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With respect to submitted Form PTO-1449, the references with a line through them were not considered as translations were not provided.

In view of the fact that additional errors in the original patent have been corrected through amendments to the claims, a new/supplemental oath or declaration complying with 37 CFR 1.175(a)(1), (a)(2) and/or (a)(3), (a)(5), (a)(6), and (a)(7) is required.

Claims 1-15 are allowed.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-30 and 38-45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant does not teach any and all types of non-destructive assays. Only non-destructive chemotaxis assays are contemplated. Applicant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis assays. To make and

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use the invention with non-destructive assays, other than chemotaxis, would involve extensive experimentation.

Applicant does not teach any and all types of permeable, detection-blocking membranes. Only radiation opaque membranes are contemplated. Applicant does not consider other permeable, detection-blocking membranes. To make and use the invention with permeable, detection-blocking membranes, other than radiation opaque membranes, would involve extensive experimentation.

Applicant does not teach any and all types of agents. Only chemical agents are contemplated. To make and use the invention with an agent other than a chemical agent would involve extensive experimentation.

Claims 23-30 and 38-45 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application.

The claims have been broadened as Applicant does not teach any and all types of non-destructive assays, any and all types of permeable detection-blocking membranes, and any and all types of agents.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-30 and 38-45 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shi et al or Watanabe et al.

Shi et al teach a chemotaxis assay comprising migration of cells through a polycarbonate membrane in a chemotaxis chamber where measurement of migration is non-destructive (see abstract). Shi et al also teach a polycarbonate membrane which is the same as that disclosed by the Applicant (see column 6, lines 10-26).

Watanabe et al teach a chemotaxis assay comprising migration of leukocytes across a filter in response to a chemoattractant where measurement of migration is non-destructive (see abstract).

The claims appear to differ as to the specific recitation of a detection-blocking membrane.

The property of detection-blocking would be inherent and/or obvious to that of the prior art as the same components are employed.

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All of the claim limitations have been considered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 308-1979. The examiner can normally be reached on Tuesday-Thursday from 6:30 AM to 3:00 PM.

The fax number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script that reads "Leslie Wong". The signature is written in black ink and is positioned above the printed name and title.

**Leslie Wong**  
**Primary Examiner**  
**Art Unit 1761**

LAW  
June 29, 2000